



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

HL

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 097025,635 | 02/18/98 | PANG | S 19603/1552(1) |

MICHAEL L GOLDMAN
NIXON HARGRAVE DEVANS & DOYLE
CLINTON SQUARE
P O BOX 1051
ROCHESTER NY 14603

HM22/1005

EXAMINER
ZAGHMOUT, O

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1649 | 10 |

DATE MAILED: 10/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/025,635

Applicant(s)

Pang et al.

Examiner
Ousama Zaghmout

Group Art Unit
1649



☒ Responsive to communication(s) filed on Feb 18, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-92 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-92 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1649

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, 23-41 are drawn to DNA construct comprising fusion gene comprising a trait DNA molecule and silencer DNA molecule, wherein the silencer DNA molecules encodes RNA molecules which are translatable, DNA expression vector, host cell transformed and transgenic plants, classified in class 800, subclass 278 for example.
 - II. Claims 1, 18, 23-39, 42-45 are drawn to DNA construct comprising fusion gene comprising a trait DNA molecule and silencer DNA molecule, wherein the silencer DNA molecules encodes RNA molecules which are not translatable, DNA expression vector, classified in class 800, subclass 278 for example.
 - III. Claims 1, 19, 46-81 are drawn to DNA construct comprising fusion gene comprising a trait DNA molecule and silencer DNA molecule, wherein the silencer DNA molecules encodes RNA molecules that are long enough impart the trait, DNA expression vector, transgenic plants, transgenic seeds and method of imparting the resistance, classified in class 800, subclass 278 for example.

Art Unit: 1649

IV. Claims 1, 20 are drawn to DNA construct comprising fusion gene comprising a trait DNA molecule and silencer DNA molecule, wherein the silencer DNA molecules encodes RNA molecules which affect post-transcriptional gene silencing within the plant, DNA expression vector, classified in class 800, subclass 278 for example.

V. Claims 1, 21 are drawn to DNA construct comprising fusion gene comprising a trait DNA molecule and silencer DNA molecule, wherein the trait DNA and the silencer DNA molecules do not interact with one another, DNA expression vector, classified in class 800, subclass 278 for example.

VI. Claims 1, 22 are drawn to DNA construct comprising fusion gene comprising a trait DNA molecule and silencer DNA molecule, wherein the silencer DNA molecule is positioned 3' to the trait DNA molecule, DNA expression vector, classified in class 530, subclass 350⁺ for example.

VII. Claims 82-92 are drawn to DNA construct comprising fusion gene comprising a trait DNA molecule and silencer DNA molecule, wherein at least some of the trait DNA molecule having a length that is insufficient to impart that trait to plant and to affect silencing of the fusion gene, DNA expression vector, transformed host cell, transgenic plants and method of imparting a trait to plant, classified in class 800, subclass 278 for example.

Art Unit: 1649

2. The inventions are distinct, each from the other because of the following reasons:
 - a. Each invention is drawn to a molecularly and a biochemically divergent products and processes not required by the other.
 - b. Groups I-VII are directed to inventions which entail the use nucleotide sequences encoding different proteins that are structurally distinct chemical compounds and unrelated to one another. The invention of group I can be practiced with the DNA molecule which encodes an RNA that is translatable, not required by group II which can be practiced with DNA molecule that encode a non-translatable protein, not by inventions of groups III-VII as described above. Clearly, they are independent since you could practice one invention, e.g., use in a DNA construct of a DNA molecule which encodes translatable RNA, without practicing or infringing any of the others. Similarly, each is patentability distinct since they constitute different products which can each support its own patent. Therefore, these inventions deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121.

As such, the invention in each one of these groups require separate search and it be burden on the Examiner to examine more than one invention in one application.

Art Unit: 1649

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently amendment of inventorship must be accompanied by a diligently-filled petition under 37 CFR 1.148(b) and the fee required under 37 CFR 1.17(h).

Art Unit: 1649

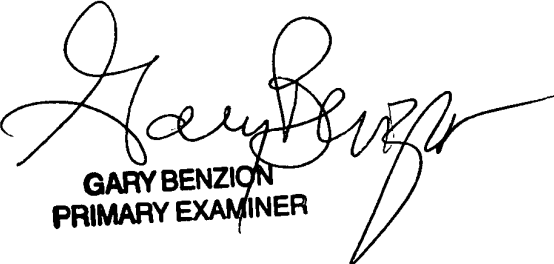
Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.
September 30, 1999


**GARY BENZION
PRIMARY EXAMINER**